

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD ALEXANDER HSI,
ARYE ROSE and CARMEN ELISA RODRIGUEZ

Appeal No. 2003-1374
Application No. 09/591,947

ON BRIEF

Before PAK, WALTZ, and DELMENDO, Administrative Patent Judges.
PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 13, 15 and 19. Claims 1 through 12, 14, and 16, the remaining claims in the instant application, have been allowed by the examiner.

APPEALED SUBJECT MATTER

According to the appellants (Brief, page 3), "[c]laims 13, 15, and 19 stand or fall together..." Therefore, for purposes of this appeal, we select claim 13 from the claims on appeal and decide the propriety of the examiner's rejection based on this claim alone consistent with 37 CFR § 1.192(c)(7) (2001). Claim 13 is reproduced below:

13. A catheter for phototherapy, comprising:

an elongated body defining an axis of elongation, a distal region, and a proximal region, said distal region being adapted for introduction into a vas of a patient;

an elongated array of semiconductor light sources associated with said catheter body near said distal region, said semiconductor light sources and said body near said semiconductor light sources being such that, when said semiconductor light sources are energized, light from said semiconductor light sources can radiate away from said body of said catheter;

electrical energization means extending along at least a portion of the length of said body from said proximal region to said array, for energizing at least some of said semiconductor light sources of said array;

a balloon associated with said distal region of said catheter, said balloon having a membrane, said membrane being at least translucent to the light produced by said semiconductor light sources, whereby light radiated away from said semiconductor body in said distal region can pass through said membrane of said balloon;

a balloon inflation lumen extending from said proximal region of said catheter to said balloon;

whereby inflation of said balloon tends to flatten folds in the wall of said vas, and energization of said semiconductor light sources allows light to reach said wall of said vas, and, in the presence of a photosensitive substance in said wall of said vas, said light reaching said wall of said vas results in fluorescence of said photosensitive substance;

said catheter further comprising:

a fluorescence light pickup and transmission arrangement at least partially located in said distal region, for receiving said fluorescence light, and for carrying a signal responsive to said fluorescence light to said proximal region, and for making said signal responsive to said fluorescence light available at said proximal region of said catheter.

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PRIOR ART

In support of his rejection, the examiner relies on the following prior art references:

Hayes et al. (Hayes)	4,967,745	Nov. 6, 1990
Prescott	5,989,245	Nov. 23, 1999 (Filed Mar. 31, 1997)

REJECTION

Claims 13, 15 and 19 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Hayes and Prescott.

OPINION

We have carefully reviewed the claims, specification and prior art, including all of the arguments advanced by both the examiner and appellants in support of their respective positions. This review leads us to conclude that the examiner's § 103 rejection is well founded. Accordingly, we will sustain the examiner's § 103 rejection for essentially those reasons expressed in the Answer and below.

The appellants do not dispute the examiner's finding that Hayes teaches a catheter corresponding to the claimed catheter, except that it employs an array of light sources (optical fibers) and an energizing means associated therewith, rather than the claimed elongated array of semiconductor light sources and

electrical energizing means associated therewith. Compare the Answer, page 4 and the final Office action dated August 13, 2002, pages 2-3, with the Brief in its entirety. Nor do the appellants dispute the examiner's finding that Prescott teaches employing the claimed elongated array of semiconductor light sources and electrical energizing means in a catheter similar to the one described in Hayes. Compare the Answer, page 4 and the final Office action dated August 13, 2002, page 3, with the Brief in its entirety.

The dispositive question is, therefore, whether it would have been obvious to employ the elongated array of semiconductor light sources and electrical energizing means taught in Prescott as the light sources and energizing means of the catheter described in Hayes. On this record, we answer this question in the affirmative.

We note that the appellants do not dispute the examiner's finding that Prescott teaches that semiconductor light sources are interchangeable with optical fiber light sources for the purpose of delivering energy to targeted tissue in the catheter art. Compare the Answer, pages 4-5, with the Brief in its entirety. The appellants also do not dispute the examiner's finding that Hayes' optical fiber light sources are used for such purpose. Compare the Answer, page 4 and the final Office action dated August 13, 2002,

page 2, with the Brief in its entirety. Thus, we concur with the examiner that the combined teachings of Hayes and Prescott would have suggested to one of ordinary skill in the art to employ either the semiconductor light sources and their associated electrical energizing means taught by Prescott or the optical fiber light sources and their associated energizing means in the catheter of the type described in Hayes. See In re Gorman, 933 F.2d 982, 986-87, 18 USPQ2d 1885, 1888-89 (Fed. Cir. 1991) ("The extent to which such suggestion [to select elements of various teachings in order to form the claimed invention] must be explicit in, or **may be fairly inferred from**, the references, is decided on the facts of each case, in light of the prior art and its relationship to the applicant's invention (emphasis ours)."); In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) ("The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art."). Accordingly, we determine that the examiner has established a prima facie case of obviousness regarding the claimed subject matter.

The appellants argue that no proper nexus is established to combine the teachings of Hayes and Prescott and then rely on, inter alia, In re Clay, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992)¹ to support their position. See the Brief, pages 4-7. Thus, it appears that the appellants are taking the position that Hayes and Prescott are nonanalogous and therefore, they are not combinable. Id. We do not agree.

As our reviewing court stated in Clay, 966 F.2d at 658-59, 23 USPQ at 1060,

Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

As is clearly apparent from the teachings of both Hayes and Prescott discussed above, they are directed to the same field of endeavor as the appellants'. They, like the claimed invention, are drawn to the same catheter art, with a particular emphasis on those employing light sources and energizing means. Thus, we cannot

¹ The appellants also refer to unpublished decisions, Oscar Mayer Foods Corp. v. ConAgra Inc., 45 F.3d 443, (Table), 35 USPQ2d 1278, 1281 (Fed. Cir. 1994) and In re Levitt, 873 F.2d 1451, (Table), 11 USPQ2d 1315, 1316 (Fed. Cir. 1989)

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agree with the appellants that Hayes and Prescott are from nonanalogous art.

In view of the foregoing, we determine that the prior art references as a whole would have rendered the claimed subject matter obvious to one of ordinary skill in the art. Hence, we affirm the examiner's decision rejection claims 13, 15 and 19 under 35 U.S.C. § 103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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ROMULO H. DELMENDO)	
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